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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,450	06/05/2001	David E. Allport	239/008-C1	6282

7590 05/07/2002
DISCOVISION ASSOCIATES
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EXAMINER

NGUYEN, JIMMY H

ART UNIT PAPER NUMBER

2673

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,450

Applicant(s)

ALLPORT, DAVID E.

Examiner

Jimmy H. Nguyen

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15, 17-24, 27-29 and 31-53 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-9, 11-15, 17-24, 27-29 and 31-53 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. It is noted that on page 1, applicant states claims 10, 16, 25, 26 and 30 cancelled, on page 9, applicant states claims 10, 16, 25, 26 and 29-31 cancelled, on page 14, applicant again states claims 10, 16, 25, 26 and 29-31 cancelled, and pages 1-9, applicant submits all pending claims including claims 29 and 31. Further, since claim 31 depends on cancelled claim 30, claim 31 should be cancelled. Accordingly, it is not clear claims 29 and 31 still pending or cancelled, and examiner therefore consider claims 1-9, 11-15, 17-24, 27-29 and 31-53 pending in the application.

2. It is noted that at least one claimed limitation, "set-top box", as recited in claim 32, is found not to be disclosed in the parent application (S/N: 09/280,524). Therefore, the pending application should be a continuation-in-part application, instead of a continuation application, as filed by applicant.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). **The drawings must show every feature of the invention specified in the claims.** Therefore, the following claimed limitations must be shown or the feature(s) canceled from the claim(s):

All steps recited in all method claims must be shown in the drawing, e.g., the **flow charts** or the like, so as to enable the examiner to have possession of the claimed invention,

Additionally, the drawing must show "a current system state of the controller" and "a previous system state of the controller", as recited in independent claims 1, 17 and 38, so as examiner has possession of what applicant means "a current system state of the controller

related to a previous state of the controller” because the examiner is unable to determine the metes and bounds of the above limitation with a fair degree of certainty,

Additionally, the drawing must show “the current system state is substantially identical to the previous state”, as recited in claims 13, 22 and 39, because the examiner is unable to determine the metes and bounds of the above limitation with a fair degree of certainty, so as the examiner may have possession of what applicant means “the current system state is substantially identical to the previous state”, and

The drawing must show “a first set of functionality” as recited in claims 27, 38 and 45, “Internet” as recited in claim 29 and “set-top box” as recited in claim 32, “a category of use associated with the consumer device”, as recited in claims 34 and 43, “a subject matter of activity within a category of use associated with the consumer device”, as recited in claims 35 and 44, “a second set of functionality” as recited in claims 36 and 45.

No new matter should be entered.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9, 11-15, 17-24, 28, 29, 34, 35 and 38-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 1-9, 11-15, 17-24 and 38-44, the application does not describe in detail or illustrate by the drawing to enable the examiner to understand the claimed limitation, “a current system state of the controller related to the a previous system state of the controller”, as recited in independent claims 1, 17 and 38. The specification only discloses “a system state the same as or similar to the system state the controller was in the last time the user had control thereof”, page 13, lines 7-10. Therefore, these claim are rejected for the reason as set forth above.

As per claims 15, 24 and 28, the specification does not disclose or teach how the current system state prevents use of the controller for accessing pay-per-view programming, and what component or part of the controller is used to communicate with the cable company. There is no disclosure how the controller communicates with the cable company or station. Therefore, theses claims are rejected for the reason as set forth above.

As per claim 29, the specification does not disclose or teach how the current system state allows use of the controller for conducting e-commerce transactions via the Internet. Therefore, theses claims are rejected for the reason as set forth above.

As per claims 34 and 43, the specification does not disclose or teach how to switch to a second system state from the first system state at a time calculated by an algorithm which incorporates a category of use associated with the consumer device, and what a category of use associated with the consumer device is. Further, the specification disclosing “For example, the time out algorithm may incorporate ... TV)”, page 14, lines 18-21, notes that the timeout algorithm may or may not incorporate factors and the time-out algorithm incorporating factors is just an example. Accordingly, theses claims are therefore rejected for the reason as set forth above.

As per claims 35 and 44, the specification does not disclose or teach how to switch to a second system state from the first system state at a time calculated by an algorithm which incorporates a subject matter of activity within a category of use associated with the consumer device, and what a subject matter of activity within a category of use associated with the consumer device is. Therefore, these claims are rejected for the reason as set forth above.

6. Claims 45-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 45-48, the application does not disclose the limitations “establishing a second system state ... user identity”, as recited in independent claim 45, line 10-17. Therefore, these claims are rejected for the reason as set forth above.

As per claim 50, the application does not disclose the limitations “the current system state prevents use of the controller for accessing pay-per-view programming by a time out feature or a lock feature” as claimed. The application discloses separately the features, “a default state may prevent access to pay-per-view programming” (see page 15, lines 3-4), and “lock feature or a time-out feature” (see page 15, lines 11-13). However, the application does not disclose a combination of these two features, i.e., preventing use of the controller for accessing pay-per-view programming by a time out feature or a lock feature is not disclosed. Therefore, this claim is rejected for the reason as set forth above.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 9, 11-15, 17, 18, 20-24, 27-29 and 31-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (USPN: 5,990,803, cited in IDS filed 06/05/2001 entered as paper No. 2) in view of Merjanian (USPN: 5,920,642, cited in IDS filed 06/05/2001 entered as paper No. 2) and further in view of Applicant's Admitted Prior Art, herein after AAPA.

As per claims 1-4, 9, 11-14, 17, 18, 20-23, 27, 31, 33-49 and 51-53, Park discloses a hand-held controller and an associated method for accessing functionality of consumer devices such as a television and other appliances, the controller (see fig. 1) comprising a fingerprint recognizer (120) (corresponding to the claimed bio-metric input component) for receiving a fingerprint pattern from a user, a display (150) (corresponding to the claimed graphical display) for displaying on the display data representing available functions to be executed, and a menu selector (110) comprising a menu key and a selection key (col. 2, lines 33-37) (corresponding to the claimed plurality of physical actuating buttons), wherein an access to the functionality of the consumer devices by the use of the controller is dependent upon the bio-metric input from the authorized user (fig 2). Park further discloses the fingerprint recognizer including a memory EPROM for storing initially fingerprint pattern of the authorized person (col. 2, lines 28-29, col. 3, lines 1-15), but Park is silent on a number of users. Accordingly, Park discloses the claimed

subject matter except for accessing to functionality by a number of users and establishing the states of the controller when using by different users or upon log-on by a first user.

However, Merjanian discloses a related hand-held controller, wherein a first user may allow to access a first set of functionality upon an identity of the first user determined by the controller based upon input to the controller from the first user, a second user may allow to access a second set of functionality upon an identity of the second user determined by the controller based upon input to the controller from the second user and so on (column 3, lines 27-53).

It would have been obvious to one of ordinary skill in the art to utilize the capability of multi-user access to functionality of the consumer device, as taught by Merjanian (col. 3, lines 27-53) in the hand-held controller of Park because this would allow a plurality of the users accessing to functionality of consumer device. However, the combination of Park and Merjanian does not disclose expressly establishing the states of the controller when using by different users or upon log-on by a first user, as claimed.

AAPA discloses that a system, which inherently comprises a controller programmed to present a user upon log-on thereto, a system state substantially to a previous system state of the controller that was in effect at the end of a previous use of the controller by the user, is well-known to one of ordinary skill in the art (page 3, line 20 through page 4, line7). Further, for first example, the first user previously caused the controller establishing a previous system state, e.g., a state of displaying a letter "A", then the second user accessed the controller without a need of log-on (since the first user did not log off the controller) and caused a letter "B" displayed on the display, so as to cause the controller having a system state, a state of displaying a letter "B",

different than the previous system state, i.e., a state of displaying a letter "A". After that, the second user manually restored the first user's previous state, i.e., a state of displaying a letter "A", and locked the controller either manually or automatically, after some delay time. When the first user logs back on to the controller, the controller establishes a current system state, which is the same as the previous state, i.e., a state of displaying a letter "A". Accordingly, AAPA obviously discloses the claimed features, "establishing a current system state of the controller related or similar or substantially identical or identical to a previous system state" and "said use of the controller by the second user caused the controller to have a system state different than the previous state", as recited in the claims. Second example, the second user previously caused the controller establishing a previous system state, e.g., a state of displaying a letter "A", and automatically logging off after a predetermined delay time, then the first user logged on to the controller, so as to cause the controller establishing a first system state, which is the same as the previous system state, i.e., a state of displaying a letter "A". After a predetermined time or delay time, the controller automatically logged off, and when the second user logs back onto the controller, the controller establishes a second system state, which is the same as the first system state as well as the previous system state, i.e., a state of displaying a letter "A". Accordingly, AAPA obviously discloses the claimed features, "switching to a second system state from the first system state in response to .. system state", as recited in claim 38, lines 10-14, and similarly recited in claim 51. Third example, the first user previously caused the controller having a previous system state, e.g., a state of displaying a letter "A", then the second user accessed the controller without a need of log-on (since the first user did not log off the controller) and caused a letter "B" displayed on the display, so as to cause the controller

having a system state, a state of displaying a letter “B”, different than the previous state, i.e., a state of displaying a letter “A”. After that, the second user locked the controller either manually or automatically, after some delay time. When the first user logs back on to the controller, the controller establishes a current system state, which is the same as the system state, i.e., a state of displaying a letter “B”, and different from the previous system state. Accordingly, AAPA obviously discloses the claimed feature, as additionally recited in the claim 52. Fourth example, the first user previously caused the controller having a previous system state, e.g., a state of displaying a letter “A”, then the second user accessed the controller without a need of log-on (since the first user did not log off the controller) and caused the controller having a system state, which is similar to the previous state, i.e., a state of displaying a letter “A” after used for a while, and finally caused the controller having some state different than the previous state, e.g., a state of displaying a letter “B”, before locking the controller either manually or automatically, after some delay time. When the first user logs back on to the controller, the controller establishes a current system state, which is the state of displaying a letter “B” and different from the previous system state. Accordingly, AAPA obviously discloses the claimed feature, as additionally recited in the claim 53.

It would have been obvious to utilize of AAPA’s teachings, as discussed above, in the hand-held controller of Park in view of Merjanian, because this would allow the user immediately logging back to the previous state at any time. Therefore, it would have been obvious to combine Merjanian and AAPA with Park to obtain the invention as specified in claims above.

In regard to claims 15, 24, 28 and 50, Merjanian further teaches the controller having a state to prevent use of the controller for accessing pay-per-view programming (col. 3, lines 39-47). These claims are therefore rejected for the reason as set forth above.

In regard to claim 29, Park further teaches the controller having a state to conduct e-commerce transactions via the Internet (col. 3, lines 16-22). This claim is therefore rejected for the reason as set forth above.

In regard to claim 32, Merjanian further teaches the consumer device being a set-top box (col. 3, lines 27-31). This claim is therefore rejected for the reason as set forth above.

9. Claims 5-8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Merjanian and AAPA, and further in view of Sirbu (USPN: 6,070,796, cited in IDS filed 06/05/2001 entered as paper No. 2).

As per claims above, as described above, Park in view of Merjanian and AAPA discloses the claimed subject matter except that the bio-metric input component is a microphone and the bio-metric input comprises the voice data, as claimed.

However, Sirbu discloses a related hand-held controller comprising a bio-metric input component which is a microphone (MIC) and a bio-metric input to a microphone comprising voice data (fig. 7, col. 7, line 48 – col. 8, line 32).

It would have been obvious to one of ordinary skill in the art to substitute the fingerprint pad of Park or to provide the hand-held controller of Park with the microphone of Sirbu in order to provide a user, especially for a user having an injured finger, another convenient means to control the access of the functionality of the consumer device, as taught by Sirbu (col. 29-32).

Therefore, it would have been obvious to combine Sirbu, Merjanian and AAPA with Park to obtain the invention as specified in claims above.

Response to Arguments

10. Applicant' arguments filed 02/07/2001, have been fully considered as follows:

In response to applicant' response with respect to drawing objection, please see the new drawing objection above.

Applicant' arguments with respect to the rejection under 35 USC 112 to claims 1-26 and 38-44, pages 10-13, have been fully considered but they are not persuasive because the specification describes the claimed subject matter in such a way not as to enable the examiner understand the claimed invention, especially the claimed limitations being not illustrated by the drawings used to help the examiner understand the claimed invention, e.g., what applicant means the states being related, substantially identical or etc.. Therefore, the rejection is maintained.

Applicant' argument with respect to the rejection under 35 USC 112 to claims 15, 24 and 28, page 13, has been fully considered but it is not persuasive, please refer to the detailed rejection above.

Applicant' arguments with respect to the rejection under 35 USC 112 to claims 34, 35, 43 and 45, have been fully considered but they are not persuasive, please refer to the detailed rejection above.

As overall regarding to the 112 rejections, the applicant does not illustrate all the claimed limitations in the drawings to assist the examiner to understand the connections of the claimed invention, e.g., the ordered sequences of the claimed methods which are usually illustrated by the flow charts.

With respect to the double patenting rejection, this rejection is overcome by the terminal disclaimer and therefore withdrawn.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (703) 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JHN
May 5, 2002


BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600